

1 KEKER & VAN NEST LLP
ROBERT A. VAN NEST - # 84065
2 rvannest@kvn.com
CHRISTA M. ANDERSON - # 184325
3 canderson@kvn.com
DANIEL PURCELL - # 191424
4 dpurcell@kvn.com
633 Battery Street
5 San Francisco, CA 94111-1809
Telephone: (415) 391-5400
6 Facsimile: (415) 397-7188

7 KING & SPALDING LLP
BRUCE W. BABER (pro hac vice)
8 bbaber@kslaw.com
1180 Peachtree Street, N.E.
9 Atlanta, Georgia 30309-3521
Telephone: (404) 572-4600
10 Facsimile: (404) 572-5100

11 Attorneys for Defendant
GOOGLE INC.

12 UNITED STATES DISTRICT COURT
13 NORTHERN DISTRICT OF CALIFORNIA
14 SAN FRANCISCO DIVISION

15 ORACLE AMERICA, INC.,

16 Plaintiffs,

17 v.

18 GOOGLE INC.,

19 Defendant.

Case No. 3:10-cv-03561 WHA

**DEFENDANT GOOGLE INC.'S
RESPONSE TO ORACLE'S CRITIQUE
OF DRAFT FAIR USE INSTRUCTIONS**

20 Dept.: Courtroom 8, 19th Fl.
Judge: Hon. William Alsup

1 Defendant Google Inc. (“Google”) respectfully submits the following in response to the
2 Court’s April 14, 2016 Request For Further Response Re Fair Use Instructions (ECF No. 1666).

3 Oracle’s critique of the Court’s draft instructions on fair use (ECF No. 1663) is not fairly
4 responsive to the Court’s request; relies on specific words or phrases in the draft instructions to
5 argue that the jury will not follow the instructions as a whole; and seeks to improperly incorporate
6 in the instructions only language from the Federal Circuit opinion or other sources that Oracle
7 believes is favorable to it. Oracle’s critique reflects Oracle’s continued unhappiness with the
8 Federal Circuit’s express acknowledgement that fair use must be decided on a case-by-case basis
9 in view of all the relevant evidence, including the four “nonexclusive” factors identified in 17
10 U.S.C. § 107, *Oracle Am. v. Google Inc.*, 750 F.3d 1339, 1371 (Fed. Cir. 2014) (quoting *Harper*
11 *& Row v. Nation Enters.*, 471 U.S. 539, 549 (1985)), and the Federal Circuit’s conclusion that the
12 issue of fair use must be submitted to the jury. *Id.* at 1376-78.

13 Oracle’s critique is in effect a request that a verdict be directed in Oracle’s favor on
14 certain issues, based on selected language in the Federal Circuit opinion. *E.g.*, ECF No. 1663
15 (Oracle Critique) at 2 (“the instruction on commercial use should direct a finding in Oracle’s
16 favor”); *id.* at 5 (citing alleged Federal Circuit “findings” regarding Java ME). The Federal
17 Circuit did not purport to make any “findings” that are controlling on any of the factual issues to
18 be considered by the jury; it instead determined that the fair use issue could not be decided on the
19 record before it.

20 In its request for critiques of the draft instructions, the Court asked the parties to limit their
21 critiques to “their best points” and reserve “lesser objections” for now. Oracle’s response
22 nonetheless criticizes virtually every portion of the Court’s instructions and even raises issues
23 regarding the use of specific words in the draft instructions. *E.g.*, ECF No. 1663 (Oracle
24 Critique) at 2 (use of “productive”); *id.* at 4 (use of “innovative”). In doing so, Oracle takes
25 individual words and phrases in the draft instructions out of context to argue that they will cause
26 the instructions as a whole to provide the jury with incorrect guidance. *E.g.*, *id.* at 1 (arguing that
27 reference in draft instructions to “plagiarism” will cause jury to believe that the Copyright Act
28 protects only against counterfeiting); *id.* at 2 (arguing that use of “productive” will cause jury to

1 believe that “productivity” alone defines transformative uses).

2 Oracle’s arguments are premised on the unstated and unwarranted assumption that the
3 jury will not follow the Court’s direction to consider the instructions as a whole, will focus on one
4 word or phrase, will take that word or phrase out of context, and will base its verdict on a
5 misunderstanding of that word or phrase, notwithstanding the Court’s clear instruction that the
6 jury must explore, discuss and evaluate all of the relevant fair use factors and weigh them
7 together in light of the purposes of copyright. ECF No. 1615 (Draft Instructions) at 5. There is
8 no basis for this assumption. Read as a whole, the Court’s draft instructions explain to the jury
9 that they must decide the fair use issue based on consideration of several different factors and that
10 no one factor is dispositive. *Id.*

11 Oracle also levies criticisms that are legally flawed. Oracle takes issue, for example, with
12 the Court’s language regarding “adding value.” ECF No. 1663 (Oracle Critique) at 2. In one of
13 its most recent fair use decisions, however, the Ninth Circuit expressly recognized that a use is
14 transformative if it “*adds value* to the original—if the quoted matter is used as raw material,
15 transformed in the creation of new information, new aesthetics, new insights and understandings”
16 and that the addition of such value “is the very type of activity that the fair use doctrine intends to
17 protect for the enrichment of society.” *Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1176 (9th Cir.
18 2013) (emphasis added) (*quoting* P. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV.
19 1105 (1990)).

20 The Court’s use of the term “productive” in the draft instructions, *see* ECF No. 1615
21 (Oracle Critique) at 2, is also appropriate. *See Seltzer*, 725 F.3d at 1176 (quoting Judge Leval’s
22 article for the proposition that, to be transformative, the use “must be productive” and employ the
23 quoted material “in a different manner” or for a different purpose); *see also Harper & Row*, 471
24 U.S. at 561 (recognizing that whether news article is a “productive use” is “one factor in a fair use
25 analysis”); *Sony Corp. v. Universal City Studios*, 464 U.S. 417, 455 n.40 (1984) (rejecting
26 categorical test based on whether use is “productive,” but noting that the distinction between
27 “productive” and “unproductive” uses “may be helpful in calibrating the [fair use] balance.”).

28 Oracle’s criticism regarding the Court’s reference to “transformative use” in connection

1 with the third factor, ECF No. 1663 (Oracle Critique) at 4, is similarly unfounded. In *Campbell*,
2 the Supreme Court acknowledged that factors three and one are properly related to one another.
3 *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 586-87 (1994) (the enquiry with respect to
4 the third factor “harkens back to the first of the statutory factors, for, as in prior cases, we
5 recognize that the extent of permissible copying varies with the purpose and character of the
6 use.”); *id.* at 587-88 (“a dearth of transformative character or purpose” may be shown if a
7 substantial portion of the second work was copied verbatim from the first).

8 Finally, Oracle cites the Federal Circuit’s opinion only selectively. For example, Oracle
9 suggests that the Court should incorporate as “findings” certain of the Federal Circuit’s
10 observations regarding the evidence at the first trial regarding Java ME. ECF No. 1663 (Oracle
11 Critique) at 5; *see Oracle Am.*, 750 F.3d at 1350. But Oracle ignores that the Federal Circuit
12 expressly later found that “there are material facts in dispute on this factor.” 750 F.3d at 1377.
13 Oracle also ignores the next sentence of the opinion, which noted that “Sun/Oracle has never
14 successfully developed its own smartphone platform using Java.” *Id.* at 1350.

15 More importantly, Oracle would prefer that the instructions not include any references to
16 the issues of interoperability, compatibility, necessity and developer familiarity that the Federal
17 Circuit “expressly noted” were potentially relevant to two of the four fair use factors. *Id.* at
18 1376-77; *see also id.* at 1371-72; ECF No. 1661 (Google Critique) at 4-5. As the Federal Circuit
19 found, these issues are “particularly” significant with respect to the “those core packages which it
20 seems may be necessary for anyone to copy if they are to write programs in the Java language” as
21 well as other packages that are “similarly essential components of any Java language-based
22 program.” *Oracle Am.*, 750 F.3d at 1377 (“We find this particularly true . . .”).

23 For the jury instructions to reflect the guidance that the Federal Circuit provided, the
24 instructions should include these issues as well as the language regarding functional works, ECF
25 No. 1615 (Draft Instructions) at 4, with which Oracle also incorrectly takes issue. ECF No. 1663
26 (Oracle Critique) at 4. The Federal Circuit made clear that “the functional aspects of the
27 packages” should be considered in connection with fair use. *Oracle Am.*, 750 F.3d at 1377-78.

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KEKER & VAN NEST LLP

By: /s/ Robert A. Van Nest
ROBERT A. VAN NEST

Attorneys for Defendant
GOOGLE INC.